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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,140	11/25/2003	Johan Wilhelm Stjerschantz	PC30246J	9449

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AGOURON PHARMACEUTICALS, INC.
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EXAMINER

ANDERSON, REBECCA L

ART UNIT PAPER NUMBER

1626

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/723,140

Applicant(s)

STJERNSCHANTZ ET AL.

Examiner

Rebecca L. Anderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 24-38 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claims 24-38 are currently pending in the instant application.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 24 and 29 drawn to products classified in class 562 subclass 471 of **13,14-dihydro-17-phenyl-18,19,20-trinor-PGF_{2α}-isopropylester**
- II. Claims 25 and 31 drawn to products classified in class 562 subclass 463 of **15-dehydro-17-phenyl-18,19,20-trinor-PGF_{2α}-isopropylester**
- III. Claim 26 and 33 drawn to products classified in class 562 subclass 463 of **13,14-dihydro-17-phenyl-18,19,20-trinor-PGA₂-isopropylester**
- IV. Claims 27, 28, 35 and 37 (in part) drawn to products classified in class 562 subclass 471 of formulas:
(7) 15-(R)-17-phenyl-18,19,20-trinor-PGF_{2α}-isopropylester
16-phenyl-17,18,19,20-tetranor-PGF_{2α}-isopropylester
17-phenyl-18,19,20-trinor-PGF_{2α}-isopropylester
18-phenyl-19,20-dinor-PGF_{2α}-isopropylester
19-phenyl-20-nor-PGF_{2α}-isopropylester
- V. Claims 28 and 37 (in part) drawn to products classified in class 562 subclass 471 of **16-phenoxy-17,18,19,20-tetranor-PGF_{2α}-isopropylester**
- VI. Claims 28 and 37 (in part) drawn to products classified in class 562 subclass 463 of **17-phenyl-18,19,20-trinor-PGE₂-isopropylester**
- VII. Claims 28 and 37 (in part) drawn to products classified in class 562 subclass 471 of **16-[4-(methoxy)-phenyl]-17,18,19,20-tetranor-PGF_{2α}-isopropylester**

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VIII. Claim 30 drawn to methods of use of the product classified in class 514 of

13,14-dihydro-17-phenyl-18,19,20-trinor-PGF_{2α}-isopropylester

IX. Claim 32 drawn to methods of use of the product classified in class 514 of

15-dehydro-17-phenyl-18,19,20-trinor-PGF_{2α}-isopropylester

X. Claim 34 drawn to methods of use of the product classified in class 514 of

13,14-dihydro-17-phenyl-18,19,20-trinor-PGA₂-isopropylester

XI. Claim 36 and 38 (in part) drawn to methods of use of the products

classified in class 514 of the formulas:

(7) 15-(R)-17-phenyl-18,19,20-trinor-PGF_{2α}-isopropylester

16-phenyl-17,18,19,20-tetranor-PGF_{2α}-isopropylester

17-phenyl-18,19,20-trinor-PGF_{2α}-isopropylester

18-phenyl-19,20-dinor-PGF_{2α}-isopropylester

19-phenyl-20-nor-PGF_{2α}-isopropylester

XII. Claim 38 (in part) drawn to methods of use of the products classified in

class 514 of **16-phenoxy-17,18,19,20-tetranor-PGF_{2α}-isopropylester**

XIII. Claim 38 (in part) drawn to methods of use of the products classified in

class 514 of **17-phenyl-18,19,20-trinor-PGE₂-isopropylester**

XIV. Claim 38 (in part) drawn to methods of use of the products classified in

class 514 of **16-[4-(methoxy)-phenyl]-17,18,19,20-tetranor-PGF_{2α}-isopropylester**

Inventionss I-VII are independent and distinct products which differ materially in structure and composition as for example by a keto or an ether.

Inventions VIII to XIV are independent and distinct methods which differ materially in the product used, for example by a keto or an ether.

Inventions I and VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the products as claimed can be practiced with another materially different product as can be seen by the instant products of inventions II-VII.

Inventions II and IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the products as claimed can be practiced with another materially different product as can be seen by the instant products of inventions I and III-VII.

Inventions III and X are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for

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using the products as claimed can be practiced with another materially different product as can be seen by the instant products of inventions I, II and IV-VII.

Inventions IV and XI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the products as claimed can be practiced with another materially different product as can be seen by the instant products of inventions I-III and V-VII.

Inventions V and XII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the products as claimed can be practiced with another materially different product as can be seen by the instant products of inventions I-IV, VI and VII.

Inventions VI and XIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for

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using the products as claimed can be practiced with another materially different product as can be seen by the instant products of inventions I-V and VII.

Inventions VIII and XIV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the products as claimed can be practiced with another materially different product as can be seen by the instant products of inventions I-VI.

Because these inventions are distinct for the reasons given above and the search required for one group is not required for another group restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday 5:30AM to 2:00PM.

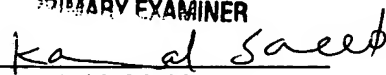
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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9/26/05

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